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| APPLICATION NO.         | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-------------------------|-------------|----------------------|---------------------|------------------|
| 09/806,463              | 05/31/2001  | Ossi Ahola           | P279296             | 2811             |
| 909                     | 7590        | 01/06/2005           | EXAMINER            |                  |
| PILLSBURY WINTHROP, LLP |             |                      | NGUYEN, THUAN T     |                  |
| P.O. BOX 10500          |             |                      | ART UNIT            |                  |
| MCLEAN, VA 22102        |             |                      | PAPER NUMBER        |                  |
|                         |             |                      | 2685                |                  |

DATE MAILED: 01/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 09/806,463             | AHOLA ET AL.        |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | THUAN T. NGUYEN        | 2685                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 1-8, 11-14 and 17-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9, 10, 15 and 16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____.  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>4/2/01</u> .  | 6) <input type="checkbox"/> Other: ____.                                    |

**DETAILED ACTION**

***Election/Restriction***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-7, 11-13, and 17-20 drawn to a method and a system for determining a home area for a subscriber terminal in a radio system, classified in class 455, subclass 414.2.
  - II. Claim 8 and 14, drawn to a subscriber network element for storing the user location information and identities, classified in class 455, subclass 433.
  - III. Claims 9-10 and 15-16, drawn to a subscriber terminal in a radio system with its components, classified in class 455, subclass 95.
2. The inventions are distinct, each from the other because of the following reasons:
3. Inventions I, II and III are related as combination and subcombinations. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because invention I drawn to a method and a system for determining a home area for a subscriber terminal in a radio system. The subcombination has separate utility whereas invention II is about a (distinct) subscriber network element for storing the user location information and identities and a (separate) subscriber terminal in a radio system with its components. See MPEP § 806.05(d).

Art Unit: 2685

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

5. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II and Group III, restriction for examination purposes as indicated is proper.

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

7. Claims 1-8, 11-14, and 17-20 withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected claims, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 6/18/04.

Applicant's election with traverse of claims 1-8, 11-14, and 17-20 in the reply filed on 6/18/04 is acknowledged. The traversal is on the ground(s) that unity of invention practice is applicable in a national stage application of PCT/FI99/00813. This is not found persuasive because the PCT practice and the US Patent Examination practice is somewhat different and not necessary following the same concept, and even within a single general concept as stated by the Applicants, but the contents for each and individual set of invention, as disclosed above, are clearly described for distinct scope of inventions.

The requirement is still deemed proper and is therefore made FINAL.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

*A person shall be entitled to a patent unless –*

*(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.*

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

9. Claims 9-10 and 15-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Salmela et al. (US patent 6,516,193 B1).

Regarding claim 9 (amended), Salmela discloses “a subscriber terminal of a radio system, comprising: transceiving means for setting up a communication link via a radio path to other parts of the system; measuring means for measuring strengths of signals received from different base stations and for storing measured results in a memory; and transmitting means for transmitting a location updating message to the other parts of the system, wherein the transceiving means are arranged to transmit the measurement results stored in the memory to the other parts of the system in response to a predetermined command received by the subscriber terminal” (col. 2/lines 9-64 for measuring of signals of base station transceivers and transceiving means between the mobile station and the base stations addressed; col. 3/lines 35 to col. 4/line 28, Fig. 3A and col. 6/lines 17-64 for location updating from the mobile user, with Fig. 4A, and col. 7/line 55 to col. 8/line 5 for mobile station has memory for storing measurement data or

Art Unit: 2685

information of location updating data; and as in Fig. 1, and col. 10/lines 23-32 for signal strengths of base station transceivers of plurality of different base stations are determined for a list of acceptable cells for communications).

As for claim 10 (amended), in view of claim 9, Salmela further discloses “wherein the transmitting means are arranged to transmit the measurement results in a short message to the other parts of the system” (col. 10/lines 1-22 for USSD or short message addressed).

Regarding claim 15 (new), Salmela discloses “a subscriber terminal of a radio system, comprising: a transceiving unit configured to set up a communication link via a radio path to other parts of the system and configured to transmit measurement results stored in a memory to the other parts of the system in response to a predetermined command received by the subscriber terminal; a measuring unit configured to measure signal strengths received from different base stations to produce the measurement results and configured to store the measurement results in the memory; and a transmitting unit configured to transmit a location updating message to the other parts of the system” (col. 2/lines 9-64 for measuring of signals of base station transceivers and transceiving means between the mobile station and the base stations addressed; col. 3/lines 35 to col. 4/line 28, Fig. 3A and col. 6/lines 17-64 for location updating from the mobile user, with Fig. 4A, and col. 7/line 55 to col. 8/line 5 for mobile station has memory for storing measurement data or information of location updating data; and as in Fig. 1, and col. 10/lines 23-32 for signal strengths of base station transceivers of plurality of different base stations are determined for a list of acceptable cells for communications).

Art Unit: 2685

As for claim 16 (new), in view of claim 15, Salmela further discloses “wherein the transmitting unit is configured to transmit the measurement results in a short message to the other parts of the system” (col. 10/lines 1-22 for USSD or short message addressed).

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Tikka et al, Beeson, Jr. Et al and Chang et al (PTO-892 attached) disclose communication systems related to location update and measuring signal strengths from the mobile station.

11. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

**(703) 872-9306, (for Technology Center 2600 only)**

*Hand-delivered responses should be brought to Crystal Park II,  
2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).*

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tony Thuan Nguyen whose telephone number is (703) 308-5860. The examiner can normally be reached on Monday-Friday from 9:30 AM to 7:00 PM, with alternate Fridays off.

Art Unit: 2685

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Technology Center 2600 Customer Service Office** whose telephone number is **(703) 306-0377**.

A handwritten signature in black ink, appearing to read 'Tony T. Nguyen', with a stylized flourish at the end.

**TONY T. NGUYEN**  
**PATENT EXAMINER**

Tony T. Nguyen  
Art Unit 2685  
December 23, 2004